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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,902	08/04/2003	Joel D. Cooper	BRONNE00104	3792

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LEVINE BAGADE HAN LLP
2483 EAST BAYSHORE ROAD, SUITE 100
PALO ALTO, CA 94303

EXAMINER	
SHAY, DAVID M	

ART UNIT	PAPER NUMBER
3735	

MAIL DATE	DELIVERY MODE
06/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/633,902	COOPER	
	Examiner	Art Unit	
	david shay	3735	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *April 18, 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *12-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *12-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Applicant argues that the examiner had not sufficiently set forth the basis for the obviousness double patenting rejections. While the examiner does not agree, the basis therefore will be expanded upon for applicant's edification. With regard to US Patent 7,175,644, attention is respectfully invited to claims 1 and 20, thereof, the bodies of these claims are identical, except for minor wording differences in the last clause, thus the only substantive difference in these claims is in the preambles: claim 1 recites "A implantable conduit for maintaining an opening in tissue, the conduit being detachable from a balloon catheter for remote implantation within the opening, the conduit comprising:"; claim 20 recites an implant for placement in an opening within an airway wall, the implant being remotely deployable from a catheter to remain within the opening and comprising:"; since the device of claim 20 has a passageway between the two ends thereof, it, too is a conduit, and would be detachable from a balloon catheter (i.e. by deflating the balloon), the only difference between these claims is the reference to the opeing in which it is intended to be used being an airway wall. As claims in a patent are required by 35 U.S.C. 112 to be of differing scope, and as these claims are part of an issued US patent, with it's attendant presumption of validity, one can only conclude that the intellectual property circumscribed by claim 20 is a device which must used in an opening in an airway passage opening, thus claim 20, at least is appropriate for a double patenting rejection. With regard to US Patents 7,022,088, 6,749,606, and 6,712,812 these patents all claim devices, which are designed for (and in the case of 6,712,812, claimed for) use in the lungs airways. Employing the devices to create a collateral channel in the lung, requires a site for the channel to be chosen; creating the channel with the device; the creation of the channel with the device, given that the device has a channel therein, also constituting inserting a conduit (i.e. the device) therein, which

is subsequently removed. Essentially, in each of the four cases, the examiner believes it is obvious to use the devices for what they are for. Thus the double patenting rejections have been maintained.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 12-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 7,022,088. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the use of the device in the patent claims would read on the claimed method, given that the device has a lumen therein.

Claims 12-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 7,175,644. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the use of the device in the

patent claims would read on the claimed method, given that the applicator for the device has a lumen therein.

Claims 12-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,749,606. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the use of the device in the patent claims would read on the claimed method, given that the device has a lumen therein.

Claims 12-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,712,812. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of the device in the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the use of the device in the patent claims would read on the claimed method, given that the device has a lumen therein.

Claims 12-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,629,951. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent anticipate the claims of the application. Accordingly, instant application claims are not patentably distinct from the patent claims. Here, the use of the device in the patent claims would read on the claimed method, given that the device has a lumen therein.

Applicant's arguments filed *** have been fully considered but they are not persuasive. The arguments are not persuasive for the reasons set forth above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to david shay whose telephone number is (571) 272-4773. The examiner can normally be reached on Tuesday through Friday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor, II, can be reached on Monday, Tuesday, Wednesday, Thursday, and Friday. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAVID M. SHAY
PRIMARY EXAMINER
GROUP 330